Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 555255-012551

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on Jan. 14, 2008

Signature Debra Pejeau

Typed or printed name: Debra Pejeau

Application Number	Filed
10/783,901	02/20/2004

First Named Inventor: Jason T. Griffin

Art Unit	Examiner
2173	Shrestha, Kiran K.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 39142.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

✓ David Cochran
Signature

David B. Cochran
Typed or printed name

(216) 586-7029
Telephone number

✓ 1/14/2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012551

Group Art Unit:	2109	)
Examiner:	Shrestha, Kiran K.	)
Inventor:	Griffin	)
Serial No.:	10/783,901	) **Pre-Appeal Request For Review**
Filed:	February 20, 2004	)
For:	Predictive Text Input System for a Mobile Communication…	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This pre-appeal request for review responds to the Final Office Action mailed on September 14, 2007. Any fees due for filing this paper should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012551.

The final rejection of claims 1 and 18 as being anticipated by Williams (EP 1296216A1) under 35 U.S.C. § 102(a) should be withdrawn because, as established in the response to the last office action, Williams fails to disclose or suggest: (1) a predictive text system and device for use with a mobile device having a reduced-key QWERTY keyboard; (2) an ambiguous word list comprising a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced-key QWERTY keyboard, wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word; and (3) a predictive text system module that determines a predicted word and engages an alert mechanism on the mobile device if the input keystroke combination is present in the ambiguous word list. In response, the Final Office Action now asserts that Williams

discloses something that is "substantially similar" to the claims, which applicants maintain is an admission that the anticipation rejection is flawed and must be withdrawn.

I. Williams Fails to Disclose a "reduced-key QWERTY keyboard"

The final office action refers to page 5, table 1 of the Williams reference in support of its disclosure of "a predictive text system and device for use with a mobile device **having a reduced-key QWERTY keyboard**." (emphasis added) Table 1 of Williams is set forth below:

1 65	2 - abc	3 - def
4 - ghi	5 - jkl	6 - mno
7 - pqrs	8 - tuv	9 - wxyz
* - + 66	0 - ␣ 67	# - ⇧

Table 1. Layout of the alphanumeric keys 7.

As clearly demonstrated by the table above, however, Williams discloses a standard telephone keypad, not a reduced-key QWERTY keyboard as disclosed and claimed in the present application. (FIG. 5 of the present application shows an example of such a QWERTY keyboard) Recognizing this difference, the final office action now asserts that Williams keypad is "substantially similar to 'QWERTY' keyboard." (Final Office Action at 8) In other words, it is not a QWERTY keyboard. Applicants maintain that the "substantial similarity" test apparently being used in the final office action is not supported by the M.P.E.P., and is in fact an admission that there are differences between the claimed subject matter and the cited reference. As a consequence, the anticipation rejection over Williams cannot stand.

II. Williams Fails to Disclose a "an ambiguous word list. . ."

The final office action again refers to page 5, table 1 (set forth above), and also refers to page 2, paragraph [0003] of Williams, and in particular lines 20-24 thereof in support of its

disclosure of "*an ambiguous word list comprising a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced key QWERTY keyboard, wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word*," as set forth in claim 1, for example. Table 1 of Williams, however, certainly does not disclose the claimed "ambiguous word list" as described in claims 1 and 18. Moreover, paragraph [0003] of Williams, set forth in its entirety below, doesn't come close to describing this claim limitation either:

> **[0003]** An object of the invention is to provide a mobile phone with a predictive editing program allowing more flexible text editing. This object is achieved by providing a mobile phone having a display, a keypad having a plurality of keys associated with several letters each and a further plurality of keys, processor means controlling the display means in accordance with the operation of the keypad, a predictive editor program for generating an output containing word matching a received string of ambiguous key strokes, an editor application controlled by the processor means for editing a text based on the predictive editor programs interpretation of key strokes, and comprising means for storing strings of entered words, means for storing a sequence of key stokes, said sequence being updated upon the occurrence of a new key stroke, and being used as input to the predictive editor program, means for storing a list of matching words received from said predictive editor program, said processor means combines the text string and one word from the list of matching words for displaying in the display of at least a part of said text string and one word from the list of matching words, said one word from the list of matching words is marked in comparison to the remaining part of the text string and added to the text string upon acknowledgement by the user, and said processor means displaying a cursor marking the position at which a character can be added or deleted.

Paragraph [0003] of Williams, and in particular lines 20-24 thereof, simply do not relate to the concept of an ambiguous word list as set forth in claims 1 and 18. Rather, this portion of Williams merely states that a predictive editor program generates an output containing a word matching a received string of ambiguous key strokes and also describes an "editor application controlled by the processor means for editing a text based on the predictive editor programs interpretation of key strokes, and comprising means for storing strings of entered words, means for storing a sequence of key strokes, said sequence being updated upon the occurrence of a new key stroke. . ." Notably missing from this portion of Williams is any mention of a list of ambiguous words, where the list comprises "*a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced key QWERTY keyboard*," as required by claims 1 and 18 of this application.

Recognizing this difference, the final office action now refers to page 4, paragraphs 0029 and 0030 of Williams in an attempt to find the claimed subject matter. These portions of Williams, however, merely state that the Tegic T9 technology includes "a large intelligent dictionary that allows the editor to predict what word the user intended based on the number of key-presses and combination of key-presses," and that often "several words will match the keystrokes that are input and the user chooses the desired match from those offered by the predictive editor program." These paragraphs do not describe a list of ambiguous words where the list comprises a plurality of keystroke combinations, but instead describe some other form of "intelligent dictionary" that is not well described in these paragraphs. The final office action now asserts that this is "substantially similar to 'ambiguous word list,'" (Final Office Action at 9), thus conceding that it is not the same thing. Thus, for this additional reason the anticipation rejection over Williams cannot stand.

III. Williams Fails to Disclose an Alert, Engaged if a Keystroke Combination is Present in the Ambiguous Word List

And lastly, the final office action refers to page 3, paragraph [0022] of Williams (and in particular lines 56-58 thereof), in support of its disclosure of an alert mechanism that is engaged on the mobile device if the input keystroke combination is present in the ambiguous word list. This portion of Williams, however, which is set forth below in its entirety, only refers to highlighting letters of a word to-be-predicted as the user is typing on the telephone keypad so as to indicate to the user that the predictive editor system has not yet figured out what word is being typed, i.e., the word "has not been fixed yet."

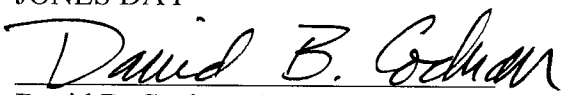
> **[0022]** Data is entered on the keypad 2 which comprises of individual alphanumerical keys 7. Most of these keys 7 have multiple meanings, represented by letter, numbers and symbols printed on the keys. The entered text is shown in the display 3 of the phone. The text already entered (and accepted by the user) is shown in the same text format as the standard display format of the phone. The word presently being entered is underlined or reversed in colours in order to indicate that the letter string has not been fixed yet. The predictive editor is able to interpret individual keys and multiple key sequences in several ways simultaneously.

As described in more detail in the present application, the point of engaging the alert mechanism in the claimed invention is to point out to a user of the mobile device having a reduced-key QWERTY keyboard that the word which has been predicted may not in fact be the word that the user meant to type. Because certain keystroke combinations may not be easily discernable by the system, the alert mechanism, when combined with the appearance of the keystroke combination on the ambiguous word list, alerts the user that they may want to pay close attention to the predicted word so as to ensure the proper meaning of the entered text.

Recognizing this difference, the final office action now refers to fig. 8: item 75 of Williams for its disclosure of "predictive editor program runs out of possible word matches during the typing of a word, the display will show a unique error symbol," which is asserted to be "substantially similar to 'a alert mechanism.'" (Final Office Action at 9). This "error symbol" linked to the inability of the editor program to find a word match does not appear to have much, if anything, in common with the claimed "alert" which is engaged when a word is found on the ambiguous word list. Once again, the use of this "substantial similarity" test appears to be an admission that the anticipation rejection is flawed. For this additional reason, the anticipation rejection over Williams cannot stand.

Respectfully submitted,

JONES DAY



David B. Cochran (Reg. No. 39,142)
Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7506